UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,812	03/18/2004	Thomas D. Smith III	4056-003 4845	
7590 05/24/2007 Thomas D. Smith III 7008 Londing Rd			EXAMINER HAYES, BRET C	
7008 Landing Rd. Oklahoma City, OK 73132			ART UNIT	PAPER NUMBER
			3641	
			MAIL DATE	DELIVERY MODE
			05/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)				
Office Action Comments	10/803,812	SMITH, THOMAS D.				
Office Action Summary	Examiner	Art Unit				
	Bret Hayes	3641				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING D.  Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from to, cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status	•					
1) ☐ Responsive to communication(s) filed on 27 M 2a) ☐ This action is <b>FINAL</b> . 2b) ☐ This 3) ☐ Since this application is in condition for alloware closed in accordance with the practice under E	action is non-final.					
Disposition of Claims						
4) ☐ Claim(s) 1-10,38-48 and 55-57 is/are pending 4a) Of the above claim(s) is/are withdray 5) ☐ Claim(s) 1-10 and 38-48 is/are allowed. 6) ☐ Claim(s) 55-57 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or	wn from consideration.					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Example 11.	epted or b) objected to by the I drawing(s) be held in abeyance. See tion is required if the drawing(s) is obj	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>						
Attachment(s)  1) Notice of References Cited (PTO-892)	4) Interview Summary					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:					

Application/Control Number: 10/803,812 Page 2

Art Unit: 3641

#### **DETAILED ACTION**

## Claim Rejections - 35 USC § 112

- 1. Claims 55 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 55 recites, in part, a "method comprising producing...a label by imprinting a sheet material with markings." (Emphasis added.) No such language can be found in the specification filed 18 MAR 04. There is no support for the method of manufacture being claimed.
- 2. Claims 56 and 57 are rejected as being dependent upon a rejected base claim.

# Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 4. Claims 55 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubbert (previously cited) in view of US Patent No. 5,065,519 to Bindon.
- 5. Re claim 55, Rubbert discloses the claimed invention including a method comprising producing a riflescope reticle with markings including a zeroed range value associated with orthogonally intersecting center vertical and center horizontal hairline, and having three or more range values, each associated with and at least three straight horizontal range-marker hairlines of sequentially incremental length disposed below said center horizontal hairline in vertically

Art Unit: 3641

bisected relationship with said center vertical hairline, as seen in FIGS. 1 & 2, for example, distance-measuring and aiming indicia 1, 3, 5, 7 & 9, for example, wherein said range values indicating ranges at which each intersection of said vertical hairline and each horizontal hairline represent points of impact for a corresponding bullet, cartridge, and rifle, except for (1) having four or more range values each associated with at least four straight horizontal range-marker hairlines and (2) the markings of the reticle being a label produced by imprinting a sheet material.

With respect to Rubbert only disclosing three such values/hairlines, it would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the values/hairlines as many times as feasible/desirable, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St, Regis Paper Co. v. Bemis Co., 193 USPQ 8. In this case, the invention would work regardless of the number of such values/hairlines provided that they were not too crowded on the reticle.

With respect to Rubbert not disclosing the method of producing the reticle label, Bindon teaches that it has been well known in the art to "to apply a white circle via paint, decal, etc. around the sapphire lens", set forth at col. 5, lines 25 - 39, for the purpose of improving day sighting characteristics. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the reticle of Rubbert to include a decal as taught by Bindon in order to improve sighting characteristics. With respect to the recited limitations of 'imprinting a sheet material', it is asserted that 'a decal' would inherently anticipate, and thus obviate, a sheet material having markings imprinted upon it. The method of manufacturing a decal, whether set

Application/Control Number: 10/803,812 Page 4

Art Unit: 3641

forth explicitly or not, would be obvious to one of ordinary skill in the art at the time the invention was made.

- 6. Re claim 56, Rubbert in view of Bindon discloses the claimed invention including further comprising affixing said label to a rifle or riflescope mounted on a rifle, wherein said rifle is capable of firing said corresponding bullet and cartridge, and where said riflescope is equipped with a corresponding riflescope reticle having said four or more range-marker hairlines. Because Bindon discloses a decal, for example, and it is well known that decals are 'labels affixed' to whatever surface desired, this further step of the method of using the device would also be obvious to one of ordinary skill in the art at the time the invention was made. With respect to the 'capable of' recitation, it has been held that the recitation that an element is "capable of' performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. In this case, either Rubbert or Bindon is so capable.
- 7. Re claim 57, Rubbert in view of Bindon further discloses loading the rifle with a corresponding bullet and cartridge as an inherent element of firing a weapon.

### Allowable Subject Matter

8. Claims 1 - 10 and 38 - 48 are allowed.

### Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Application/Control Number: 10/803,812 Page 5

Art Unit: 3641

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can normally be reached Monday through Friday from 5:30 am to 2:00 pm, Eastern Standard Time.

The Central FAX Number is 571-273-8300.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

**Bret Hayes** 

17-May-07

MICHAEL J. CARONE SUPERVISORY PATENT EXAMINER